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E. Hall

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Chauvel

Serial No.: **09/606,057**

Filed: **06/28/00**

For: **MULTIPLE PROCESSOR CELLULAR RADIO**

TI-15767A.1

Art Unit: **2816**

Examiner: **Tran**

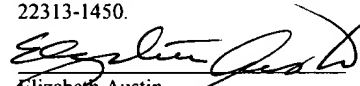
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REPLY BRIEF

Assistant Commissioner for Patents
Alexandria, VA 22313-1450

Dear Sir:

| | |
|--|-------------------|
| <u>MAILING CERTIFICATE UNDER 37 C.F.R. § 1.8(A)</u> | |
| I hereby certify that the above correspondence is being deposited with the U.S. Postal Service as First Class Mail in an envelope addressed to: Assistant Commissioner for Patents, Alexandria, VA 22313-1450. | |
|  Elizabeth Austin | 5/12/2003 Date |

In support of their appeal of the Final Rejection of claims in the above-referenced application, and in response to the Examiner's Answer dated March 10, 2003, Appellants respectfully submit herein their Reply Brief.

APPELLANTS' RESPONSE

- 1) Reply to Examiner's Response #1 (page 9, lines 4-10).

The Examiner determines:

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In response to the appellant's argument (1), the combination of Paneth and Barnes teaches the first processor being main processor of a cellular radio as stated above in the rejection with respect to claim 6. In particular, **Paneth teaches that processor 20 is the main processor of the base station** (e.g., col. 8, line 54 and et seq.). (Examiner's Answer, page 9, lines 7-10).

Appellants respectfully respond, however, that while Paneth discloses that remote connection processor (RPU) 20 is a processor, it fails to teach or suggest that processor 20 is the **main processor** of the base station or of any cellular radio, as required by Claim 6. As a result, the Examiner's determination is supposition not supported by fact. Even if processor 20 could be made to be the main processor of Paneth et al., the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Laskowski, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

2) Reply to Examiner's Response #2 (page 9, line 11 – page 10, line 21).

a. Examiner determines:

Paneth teaches the processor 20 is not only the central control (i.e., dominant control or most control) processor but also the most important control processor because it performs the system management functions, controls the other elements, such as processor 18 (col. 8, lines 23-25), modem 19, RFU 21 (col. 8, lines 44-47), control mechanism for call set up, teardown, and maintenance, and control the interconnection between codecs 16 and the Telco trunks. **Therefore, Paneth teaches the processor is the main processor of the base or the radio.** (Examiner's Answer, page 9, line 18 – page 10, line 5).

Appellants respectfully respond that the Examiner's above determination is supposition not supported by fact. Paneth actually discloses:

The remote-control processor unit (RPU) 20 is the central control processor which conveys connection data and control messages to the CCU (col. 8, lines 54-56).

Nowhere, however, does Paneth teach or suggest that processor 20 is the main processor of the base or the radio as determined by the Examiner.

b. The Examiner further determines:

Paneth teaches that processor 20 **is the main processor because it is located on a base station** (e.g., figs. 1-2, the base station and processor 20) which is the first important (i.e., primary) station (abstract line 1) and is the most control station for controlling the other stations (col. 7, lines 20-25)" (Examiner's Answer, page 10, lines 5-8).

Appellants respectfully respond, that, using the Examiner's analysis above, all the processors in the base station would qualify as "main processors" since they too are "located on a base station". As a result, the Examiner's determination is erroneous.

c. The Examiner also determines:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have a cellular radio to the system of Paneth **because it would allow distribution of many of the control functions to cell stations associated with cells; thereby, monitoring and voice function provides both security from interrupted service and significant reduced costs.** (Examiner's Answer, page 10, lines 12-14).

The Examiner's above rationale for making the combination, **"thereby, monitoring and voice function process both security from interrupted service and**

significant reduced costs", makes no sense at all. Moreover, there is no teaching in either Paneth or Barnes that supports such a determination by the Examiner.

Appellants respectfully point out that even if the cited art discloses components of the device in issue, case law holds that it is insufficient that the prior art discloses the components of the device in issue, either separately or used in other combination; there must be some teaching, suggestion, or incentive to make the combination made by the inventor. Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934, 15 USPQ2d 1321, 1323 (Fed. Cir. 1990). Moreover, "obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Laskowski, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

d. The Examiner similarly determines:

The combination of Paneth and Barnes is the prior art because the rejections based on the combination of Paneth and Barnes but not based on Paneth individually or Barnes individually. (Examiner's Answer, page 10, lines 16-18).

The Examiner's determination above is a distortion of patent law. Paneth individually and Barnes individually are the "prior art". The question at issue is whether or

not the two can be combined to support an obviousness rejection – NOT whether or not a combination of Paneth and Barnes “is the prior art”. See, Graham v. John Deere Co., 148 USPQ 459 (U.S. Sup. Ct. 1966).

3) Reply to Examiner’s Response #3 (page 11, line 1 – page 11, line 21).

a. Examiner makes the determination:

Paneth teaches the processor 27 is the most important control processor (i.e. main) because it performs all control functions of the subscriber or the radio. (Examiner’s Answer, page 11, lines 9-11).

Appellants respectfully respond that it is the Examiner, and NOT Paneth, that teaches the processor 27 is the most important control processor.

b. Examiner also makes the determination:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have a cellular radio to the system of Paneth **because it would allow distribution of many of the control functions to cell stations associated with cells; thereby, monitoring and voice function provides both security from interrupted service and significant reduced costs.** (Examiner’s Answer, page 11, lines 14-18).

The Examiner’s above rationale for making the combination, **“thereby, monitoring and voice function process both security from interrupted service and significant reduced costs”**, makes no sense at all. Moreover, there is no teaching in either Paneth or Barnes that supports such a determination by the Examiner.

Appellants respectfully point out that even if the cited art discloses components of the device in issue, case law holds that it is insufficient that the prior art discloses the components of the device in issue, either separately or used in other combination; there must be some teaching, suggestion, or incentive to make the combination made by the inventor. Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934, 15 USPQ2d 1321, 1323 (Fed. Cir. 1990). Moreover, "obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Laskowski, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

4) Reply to Examiner's Response #4 (page 11, line 19 – page 12, line 14).

a. Examiner makes the determination:

Paneth teaches a first processor for performing management **and vocoder signal processing** (e.g., fig. 2, el. 24 or 17 or 20 or fig. 3, el. 28 or 29; col. 7, line 63 and et seq. or col. 41, line 31). For example, Paneth teaches main processor 20 performing management **and vocoder signal processing by controlling the performance vocoder signal processing**, the interconnections between the codecs 16 (e.g., col. 8, lines 56-63). (Examiner's Answer, page 12, lines 3-8).

Appellants respectfully respond that the Examiner's determination above is erroneous. It is erroneous for the Examiner to determine that simply because processor 20

may “control” the performance vocoder signal processing, that processor 20 is actually “performing vocoder signal processing”, as required by the Claims. Paneth is clear that processor 20 performs NO vocoder signal processing. Whether or not processor 20 may “control” the performance vocoder signal processing does not change the fact that processor 20 does NOT perform vocoder signal processing, as required by the present claims. Accordingly, the Examiner above determination is erroneous.

b. Examiner also makes the determination:

In response to applicant’s argument that the references fail to show certain features of applicant’s invention, it is noted that the features upon which applicant relies (i.e., the vocoder function is performed by the codecs in VCU 17 not in RPU 20) are not recited in the rejected claims(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read in light of the specification, limitations from the specification are not read into the claims. (Examiner’s Answer, page 12, lines 9-13).

Appellants respectfully respond that the Examiner misinterprets the above case law. Claim 14 clearly recites, “a first processor for performing management **and vocoder signal processing**”. Claim 14 does NOT recite, “and CONTROL of vocoder signal processing”. Thus, in Claim 14, the first processor must perform “vocoder signal processing”, which processor 20 in Paneth clearly does not do. As a result, the Examiner’s determination above is erroneous. The Examiner’s above determination does not comply with case law being that, “all words in a claim must be considered in judging the patentability of that claim against the prior art.” In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

5) Reply to Examiner's Response #5 (page 12, lines 15-20).

No reply from Appellants is necessary.

6) Reply to Examiner's Response #6 (page 13, line 1 – page 14, line 3).

a. Examiner makes the determination:

Paneth teaches the processor 20 performs management **and vocoder signal processing by controlling the vocoder signal processing**, the interconnections between the codecs 16 (e.g., col. 8, lines 56-63). (Examiner's Answer, page 13, lines 5-8).

Appellants respectfully respond that the Examiner's determination above is erroneous. It is erroneous for the Examiner to determine that simply because processor 20 may "control" the performance vocoder signal processing, that processor 20 is actually "performing vocoder signal processing", as required by the Claims. Paneth is clear that processor 20 performs NO vocoder signal processing. Whether or not processor 20 may "control" the performance vocoder signal processing does not change the fact that processor 20 does NOT perform vocoder signal processing, as required by the present claims. Accordingly, the Examiner above determination is erroneous. Moreover, the Examiner's above determination does not comply with case law since, "all words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

b. Examiner further determines:

According to col. 7, lines 60-67 and fig. 2, Paneth teaches the **processor 15** (i.e., on that processes, comprising the processor 24 and converting voice information to pulse code modulation) performs management (e.g., col. 7,

lines 61-63; col. 8, lines 6-64) and vocoder signal processing (e.g., col. 7, lines 63-67). (Examiner's Answer, page 13, lines 9-12).

Appellants reply that Paneth clearly discloses PBX 15 is not a processor (col. 7, line 57 – col. 8, line 20), as determined by the Examiner. PBX 15, along with including switch matrix, further includes call processor 24. As a result, the Examiner's determination above is erroneous.

c. Examiner also determines:

In addition, col. 41, lines 31-44 and fig. 3, el. 27 and fig. 12, Paneth teaches the processor 27 (i.e., one that processes, comprising the microcontroller 58 (fig. 12) and converting voice signal) performs management (e.g., col. 42, lines 33-40) **and vocoder signal processing** (e.g., col. 41, lines 30-35). (Examiner's Answer, page 13, lines 13-16).

Appellants respectfully respond that there is no teaching in Paneth, (e.g., col. 41, lines 30-35) that teaches or suggests that processor 27 “performs vocoder signal processing”, as determined by the Examiner. Paneth is clear that processor 27 performs NO vocoder signal processing. Whether or not processor 27 may “control” the performance vocoder signal processing does not change the fact that processor 27 does NOT perform vocoder signal processing, as required by the present claims. Accordingly, the Examiner above determination is erroneous. Moreover, the Examiner's above determination does not comply with case law since, "all words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

d. Examiner yet determines:

Further more, Paneth teaches the CCU processor (i.e., one that processes, comprising the microprocessor 111 (fig. 21) and converting voice signal) performs management (e.g., col. 49, line 59 to col. 50, line 7; col. 51, lines 29-32) **and vocoder signal processing** (e.g., col. 49, lines 28-60; col. 53, lines 45-50). (Examiner's Answer, page 13, lines 17-20).

Appellants respectfully respond that there is no teaching in Paneth, (e.g., col. 49, lines 28-60 or col. 53, lines 45-50) that teaches or suggests that CCU processor 29 "performs vocoder signal processing", as determined by the Examiner. Paneth is clear that CCU processor 29 performs NO vocoder signal processing. Whether or not CCU processor 29 may "control" the performance vocoder signal processing does not change the fact that CCU processor 29 does NOT perform vocoder signal processing, as required by the present claims. Accordingly, the Examiner above determination is erroneous. Moreover, the Examiner's above determination does not comply with case law since, "all words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

e. Examiner similarly determines:

Paneth teaches the Voice Codec unit 28 is the processor (e.g., col. 42, lines 50-60) performs management (e.g., col. 46, lines 60 to col. 65) and vocoder signal processing (e.g., col. 8, lines 5-15). (Examiner's Answer, page 14, lines 1-3).

Appellants respectfully respond that the teaching in col. 46 is referenced to voice codec unit 28 (which is in the subscriber station), whereas the teaching in col. 8 is reference to voice codec unit 17, which is in the base station. The Examiner has provided

no teaching from Paneth that VCU 17 and VCU 28 are structurally equivalent. As a result, one cannot assume that they are interchangeable.

Moreover, even if there were support in Paneth that VCU 17 and VCU 28 were interchangeable and that both perform both management and vocoder signal processing, the Examiner has failed to identify what would be the second and third processors in the claim.

7) Reply to Examiner's Response #7 (page 14, lines 4-13).

Examiner determines:

The processor 20 control which voice call to be processed by which codecs (e.g., col. 8, lines 54-65; lines 4-20) **means perform vocoder signal processing.** (Examiner's Answer, page 14, lines 11-13).

Appellants respectfully respond that the Examiner's determination above is erroneous. It is erroneous for the Examiner to determine that simply because processor 20 may "control" the performance vocoder signal processing, that processor 20 is actually "performing vocoder signal processing", as required by the Claims. Paneth is clear that processor 20 performs NO vocoder signal processing. Whether or not processor 20 may "control" the performance vocoder signal processing does not change the fact that processor 20 does NOT perform vocoder signal processing, as required by the present claims. Accordingly, the Examiner above determination is erroneous. Moreover, the Examiner's above determination does not comply with case law since, "all words in a

claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

8) Reply to Examiner's Response #8 (page 14, line 14 – page 15, line 3).

Examiner states:

In response to appellant's argument that (8) the combination of Paneth and Barns is the prior art because the rejections base don the combination of Paneth and Barns but not based on Paneth individually or Barnes individually. (Examiner's Answer, page 14, lines 18-20).

The Examiner's determination above is a distortion of patent law. Paneth individually and Barns individually are the "prior art". The question at issue is whether or not the two can be combined to support an obviousness rejection – NOT whether or not a combination of Paneth and Barns "is the prior art". See, Graham v. John Deere Co., 148 USPQ 459 (U.S. Sup. Ct. 1966).

9) Reply to Examiner's Response #9 (page 15, line 14 – page 15, line 3).

Examiner states:

For example, in the broadest interpretation of the claim, el. 27, fig. 3 of Paneth reads on the main processor limitation of the claim; el. 29, fig. 3 of Paneth reads on the processor performing protocol processing limitation of the claim; and fig. 3, el. 33 or 30a or fig. 25, el. 154; col. 71, line 64 et seq. reads on the processor performing signal processor on vectors limitation of the claim. (Examiner's Answer, page 15, lines 16-20).

Appellants reply that the Examiner points to no teaching in suggestion in Paneth that supports his determination that diversity combiner 33 or modem 30a or fig. 25, el. 154; col. 71 line 64 and et seq. "reads on the processor performing signal processor on vectors

limitation on the claim". The Examiner's determination above is supposition not supported by fact.

10) Reply to Examiner's Response #10 (page 16, lines 1-18).

Examiner states:

For example, in the broadest interpretation of the claim, el. 27 or 28 fig. 3 and col. 41, line 31 and et seq. of Paneth reads on the processor performing management **and vocoder signal processing** limitation of the claim; el. 29, fig. 3 of Paneth reads on the processor performing protocol processing limitation of the claim; and fig. 3, el. 33 or 30a or fig. 25, el. 154; col. 71, line 64 and et seq. of Paneth reads on the processor performing signal processor on vectors limitation of the claim. (Examiner's Answer, page 16, lines 13-18).

Appellants respectfully respond that the Examiner's determination above is erroneous. It is erroneous for the Examiner to determine that simply because el. 27 or 28 may "control" the performance vocoder signal processing, that el. 27 or 28 is actually "performing vocoder signal processing", as required by the Claims. Paneth is clear that el. 27 and 28 perform NO vocoder signal processing. Whether or not el. 27 or 28 may "control" the performance vocoder signal processing does not change the fact that el. 27 or 28 do NOT perform vocoder signal processing, as required by the present claims. Accordingly, the Examiner above determination is erroneous. Moreover, the Examiner's above determination does not comply with case law since, "all words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

11) Reply to Examiner's Response #11 (page 16, line 19 – page 17, line 17).

Examiner states:

For example, in the broadest interpretation of the claim, el. 27 or 28 fig. 3 and col. 41, line 31 and et seq. of Paneth reads on the processor performing management **and vocoder signal processing** limitation of the claim; el. 29, fig. 3 of Paneth reads on the processor performing protocol processing limitation of the claim; and the combination of Paneth, Barnes, and Mano reads on the processor being a dedicated processor of the array type limitation of the claim as stated above the rejection with respect to claim 15. (Examiner's Answer, page 17, lines 11-17).

Appellants respectfully respond that the Examiner's determination above is erroneous. It is erroneous for the Examiner to determine that simply because el. 27 or 28 may "control" the performance vocoder signal processing, that el. 27 or 28 is actually "performing vocoder signal processing", as required by the Claims. Paneth is clear that el. 27 and 28 perform NO vocoder signal processing. Whether or not el. 27 or 28 may "control" the performance vocoder signal processing does not change the fact that el. 27 or 28 do NOT perform vocoder signal processing, as required by the present claims. Accordingly, the Examiner above determination is erroneous. Moreover, the Examiner's above determination does not comply with case law since, "all words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

12) Reply to Examiner's Response #12 (page 17, line 18 – page 17, line 6).

No reply from Appellants is needed.

13) Reply to Examiner's Response #13 (page 18, lines 7– 10).

No reply from Appellants is needed.

14) Reply to Examiner's Response #14 (page 18, line 11 – page 19, line 7).

The Examiner states:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have a cellular radio to the system of Paneth **because it would allow distribution of many of the control functions to cell stations associated with cells; thereby, monitoring and voice function provides both security from interrupted service and significant reduced costs.** (Examiner's Answer, page 19, lines 3-7).

The Examiner's above rationale for making the combination, "**thereby, monitoring and voice function process both security from interrupted service and significant reduced costs**", makes no sense at all. Moreover, there is no teaching in either Paneth or Barnes that supports such a determination by the Examiner.

Appellants respectfully point out that even if the cited art discloses components of the device in issue, case law holds that it is insufficient that the prior art discloses the components of the device in issue, either separately or used in other combination; there must be some teaching, suggestion, or incentive to make the combination made by the inventor. Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934, 15 USPQ2d 1321, 1323 (Fed. Cir. 1990). Moreover, "obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the

prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Laskowski, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

15) Reply to Examiner's Response #15 (page 19, lines 8–13).

The Examiner states:

Paneth teaches wherein said first processor performs management **and vocoder signal processing** (e.g., fig. 2, el. 24 or 17 or 20 or fig. 3, el. 28 or 29; col. 7, line 63 and et seq. or col. 41, line 31). (Examiner's Answer, page 19, lines 8-13).

Appellants respectfully respond that the Examiner's determination above is erroneous. It is erroneous for the Examiner to determine that simply because processor 20 (or elements 24 or 28 or 29) may "control" the performance vocoder signal processing, that processor 20 (or elements 24 or 28 or 29) is actually "performing vocoder signal processing", as required by the Claims. Paneth is clear that processor 20 (or elements 24 or 28 or 29) performs NO vocoder signal processing. Whether or not processor 20 (or elements 24 or 28 or 29) may "control" the performance vocoder signal processing does not change the fact that processor 20 (or elements 24 or 28 or 29) does NOT perform vocoder signal processing, as required by the present claims. Accordingly, the Examiner above determination is erroneous.

16) Reply to Examiner's Response #16 (page 19, line 14 – page 20, line 2).

No reply from Appellants is needed.

17) Reply to Examiner's Response #17 (page 20, lines 8–13).

The Examiner states:

... Paneth teaches wherein the three processor operated in parallel (e.g., abstract, line 1 and et seq). (Examiner's Answer, page 20, lines 6-7).

Appellants respect reply that Paneth discloses in its abstract, "a telecommunication **system for processing a plurality of simultaneous bidirectional communications ...**" – NOT wherein the first, second and third processors operate in parallel, as suggested by the Examiner. The Examiner's above determination does not comply with case law since, "all words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

18) Reply to Examiner's Response #18 (page 20, lines 8-12).

No reply from Appellants is needed.

19) Reply to Examiner's Response #19 (page 20, line 13 – page 21, line 2).

No reply from Appellants is needed.

20) Reply to Examiner's Response #20 (page 21, lines 3-10).

No reply from Appellants is needed.

21) Reply to Examiner's Response #21 (page 21, line 11 – page 22, line).

The Examiner states:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the teaching of Claesson into the combines system of Paneth and Barnes **because it would allow a highest performance, available in various forms and performance levels from all major semiconductor manufacturers, increase execution speed and keep the cost reasonable**, as taught by Claesson (e.g., col. 2, page 194 to col. 1, page 195). (Examiner's Answer, page 22, lines 9-14).

Appellants respectfully reply that Claesson, among other things, requires a host computer (p. 195, col. 2, lines 5-10) and the DSP900, which itself requires 8 processors. Appellants have found no teaching in Claesson that would lead one of ordinary skill in the art that combining Claesson with Paneth and Barnes would somehow result in a system that **would allow a highest performance, available in various forms and performance levels from all major semiconductor manufacturers, increase execution speed and keep the cost reasonable**, as determined by the Examiner.

Appellants respectfully point out that even if the cited art discloses components of the device in issue, case law holds that it is insufficient that the prior art discloses the components of the device in issue, either separately or used in other combination; there must be some teaching, suggestion, or incentive to make the combination made by the inventor. Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934, 15 USPQ2d 1321, 1323 (Fed. Cir. 1990). Moreover, "obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the

Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Laskowski, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

22) Reply to Examiner's Response #22 (page 22, line 15 – page 24, line 18).

a. The Examiner states:

Paneth teaches the invention substantially as claimed, a radio, comprising: a first processor performing management **and vocoder signal processing** (e.g., fig. 2, el. 24 or 17 or 20 or fig. 3, el. 28 or 29; col. 7, line 63 and et seq. or col. 41, line 31). (Examiner's Answer, page 23, lines 1-4).

Appellants respectfully respond that the Examiner's determination above is erroneous. It is erroneous for the Examiner to determine that simply because processor 20 (or elements 17 or 24 or 28 or 29) may "control" the performance vocoder signal processing, that processor 20 (or elements 17 or 24 or 28 or 29) is actually "performing vocoder signal processing", as required by the Claims. Paneth is clear that processor 20 (or elements 17 or 24 or 28 or 29) performs NO vocoder signal processing. Whether or not processor 20 (or elements 17 or 24 or 28 or 29) may "control" the performance vocoder signal processing does not change the fact that processor 20 (or elements 24 or 28 or 29) does NOT perform vocoder signal processing, as required by the present claims. Accordingly, the Examiner above determination is erroneous.

b. The Examiner states:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have a cellular radio to the system of Paneth **because it would allow distribution of many of the control functions to cell stations associated with cells; thereby, monitoring and voice function provides both security from interrupted service and significant reduced costs.** (Examiner's Answer, page 23, lines 10-14).

The Examiner's above rationale for making the combination, **"thereby, monitoring and voice function process both security from interrupted service and significant reduced costs"**, makes no sense at all. Moreover, there is no teaching in either Paneth or Barnes that supports such a determination by the Examiner.

Appellants respectfully point out that even if the cited art discloses components of the device in issue, case law holds that it is insufficient that the prior art discloses the components of the device in issue, either separately or used in other combination; there must be some teaching, suggestion, or incentive to make the combination made by the inventor. Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934, 15 USPQ2d 1321, 1323 (Fed. Cir. 1990). Moreover, "obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Laskowski, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

c. Examiner makes the determination:

Paneth teaches the processor 20 performs management and vocoder signal processing by controlling the vocoder signal processing, the interconnections between the codecs 16 (e.g., col. 8, lines 56-63). (Examiner's Answer, page 24, lines 1-3).

Appellants respectfully respond that the Examiner's determination above is erroneous. It is erroneous for the Examiner to determine that simply because processor 20 may "control" the performance vocoder signal processing, that processor 20 is actually "performing vocoder signal processing", as required by the Claims. Paneth is clear that processor 20 performs NO vocoder signal processing. Whether or not processor 20 may "control" the performance vocoder signal processing does not change the fact that processor 20 does NOT perform vocoder signal processing, as required by the present claims. Accordingly, the Examiner above determination is erroneous.

d. Examiner further determines:

According to col. 7, lines 60-67 and fig. 2, Paneth teaches the **processor 15** (i.e., on that processes, comprising the processor 24 and converting voice information to pulse code modulation) performs management (e.g., col. 7, lines 61-63; col. 8, lines 6-64) and vocoder signal processing (e.g., col. 7, lines 63-67). (Examiner's Answer, page 24, lines 4-7).

Appellants reply that Paneth clearly discloses PBX 15 is not a processor (col. 7, line 57 – col. 8, line 20), as determined by the Examiner. PBX 15, along with including switch matrix, further includes call processor 24. As a result, the Examiner's determination above is erroneous.

e. Examiner also determines:

In addition, col. 41, lines 31-44 and fig. 3, el. 27 and fig. 12, Paneth teaches the processor 27 (i.e., one that processes, comprising the microcontroller 58 (fig. 12) and converting voice signal) performs management (e.g., col. 42, lines 33-40) **and vocoder signal processing** (e.g., col. 41, lines 30-35). (Examiner's Answer, page 24, lines 8-11).

Appellants respectfully respond that there is no teaching in Paneth, (e.g., col. 41, lines 30-35) that teaches or suggests that processor 27 “performs vocoder signal processing”, as determined by the Examiner. Paneth is clear that processor 27 performs NO vocoder signal processing. Whether or not processor 27 may “control” the performance vocoder signal processing does not change the fact that processor 27 does NOT perform vocoder signal processing, as required by the present claims. Accordingly, the Examiner above determination is erroneous. Moreover, the Examiner's above determination does not comply with case law since, "all words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

f. Examiner yet determines:

Further more, Paneth teaches the CCU processor (i.e., one that processes, comprising the microprocessor 111 (fig. 21) and converting voice signal) performs management (e.g., col. 49, line 59 to col. 50, line 7; col. 51, lines 29-32) **and vocoder signal processing** (e.g., col. 49, lines 28-60; col. 53, lines 45-50). (Examiner's Answer, page 24, lines 12-15).

Appellants respectfully respond that there is no teaching in Paneth, (e.g., col. 49, lines 28-60 or col. 53, lines 45-50) that teaches or suggests that CCU processor 29 “performs vocoder signal processing”, as determined by the Examiner. Paneth is clear that

CCU processor 29 performs NO vocoder signal processing. Whether or not CCU processor 29 may "control" the performance vocoder signal processing does not change the fact that CCU processor 29 does NOT perform vocoder signal processing, as required by the present claims. Accordingly, the Examiner above determination is erroneous. Moreover, the Examiner's above determination does not comply with case law since, "all words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

g. Examiner similarly determines:

Paneth teaches the Voice Codec unit 28 is the processor (e.g., col. 42, lines 50-60) performs management (e.g., col. 46, lines 60 to col. 65) and vocoder signal processing (e.g., col. 8, lines 5-15). (Examiner's Answer, page 24, lines 16-18).

Appellants respectfully respond that the teaching in col. 46 is referenced to voice codec unit 28 (which is in the subscriber station), whereas the teaching in col. 8 is reference to voice codec unit 17, which is in the base station. The Examiner has provided no teaching from Paneth that VCU 17 and VCU 28 are structurally equivalent. As a result, one cannot assume that they are interchangeable.

Moreover, even if there were support in Paneth that VCU 17 and VCU 28 were interchangeable and that both perform both management and vocoder signal processing, the Examiner has failed to identify what would be the second and third processors in the claim.

23) Reply to Examiner's Response #23 (page 24, line 19 – page 26, line 10).

The Examiner states:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have a cellular radio to the system of Paneth **because it would allow distribution of many of the control functions to cell stations associated with cells; thereby, monitoring and voice function provides both security from interrupted service and significant reduced costs.** (Examiner's Answer, page 25, lines 11-16).

The Examiner's above rationale for making the combination, **"thereby, monitoring and voice function process both security from interrupted service and significant reduced costs"**, makes no sense at all. Moreover, there is no teaching in either Paneth or Barnes that supports such a determination by the Examiner.

Appellants respectfully point out that even if the cited art discloses components of the device in issue, case law holds that it is insufficient that the prior art discloses the components of the device in issue, either separately or used in other combination; there must be some teaching, suggestion, or incentive to make the combination made by the inventor. Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934, 15 USPQ2d 1321, 1323 (Fed. Cir. 1990). Moreover, "obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the

desirability of the modification. In re Laskowski, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

24) Reply to Examiner's Response #24 (page 26, lines 11-16).

No reply from Appellants is needed.

25) Reply to Examiner's Response #25 (page 26, line 17 – page 27, line 2).

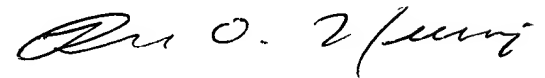
No reply from Appellants is needed.

26) Reply to Examiner's Response #26 (page 27, lines 3-8).

No reply from Appellants is needed.

For the above reasons, favorable consideration of the appeal of the Final Rejection in the above-referenced application, and its reversal, are respectfully requested.

Respectfully submitted,



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